

## **REMARKS**

In the Office Action dated November 12, 2002, the office rejected claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite, rejected claim 18 under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram, rejected claim 19 under 35 U.S.C. 103(a) as being unpatentable over Ingram, and rejected claim 20 under 35 U.S.C. 103(a) as being unpatentable over the combination of the reference of Ingram and the reference of Behensky.

### **Rejection under 35 U.S.C. 112**

Independent claim 20 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which applicant regards as the invention. In response to the Office's rejection of claim 20 under 35 U.S.C. 112, second paragraph, claim 20 has been amended to provide more clarity to the spring constants. More specifically, the applicant has amended claim 18 to call for:

“ a spring having a spring constant that is about equal to a spring constant of the bobber in water such that the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.” (Emphasis added.)

It is for the above that the applicant respectfully request that the Office's rejection of independent claim 20 under 35 U.S.C. 112, second paragraph be withdrawn.

### **Rejection under 35 U.S.C. 102(b)**

Applicant's claim 18 stands rejected under 35 U.S.C. 102(b) as being anticipated by the reference of Ingram.

**A. Ingram does not teach simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body**

In rejecting claim 18 under 35 U.S.C. 102(b), the office stated that:

“The patent to Ingram shows a two stage fishing bobber having a main body 10 and a member 12 resiliently displace able with respect to the bobber main body in response to a force on the member as disclosed in column 2, lines 20-30.” (See page 3, lines 1-3 of the office action.)

The applicant disagrees with the above rejection. Applicant’s claim 18 calls for:

“a member resiliently displaceable with respect to said bobber main body in response to a force on said member with the force on said member sufficient to overcome at least some if not all of the buoyant force of the bobber main body to thereby allow the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” (Emphasis added.)

The reference of Ingram does not teach “the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.” To the contrary, Ingram in column 2, lines 20-26 specifically states that:

“as a fish strikes the lower end of the line, the attached stem will move downwardly through the bore of the body until the top of the stem is flushed with the top surface of the body; the body then is subject to the downward pull on the line and will disappear from sight below the surface of the water.” (Emphasis added.)

Since Ingram does not teach “simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body” but instead is a contrary teaching by Ingram’s disclosure that his stem is subjected to the downward pull before the body of Ingram’s fishing float is subject to the downward pull, the applicant submits that independent claim 18 is not anticipated by the reference of Ingram.

**B. The reference of Ingram does not teach his device as providing for gradual resistance.**

On page 4, lines 9-16, the Office stated that:

“As to the gradual resistance of due to submersion of the bobber, Ingram shows the stem 12 tapering at lower tapered portion 16 and upper portion 14 so that as the stem is pulled down a gradual pull on the line as the stem displaces more water which is a gradual resistance. Since the stem is pulled down before the body 10 and displaces a much larger volume than the body, when the body is submerged, the volume of the body will cause only a gradual increase in resistance. Applicant has submitted no evidence that there is not a gradual increase in the force to displace the members of Ingram. Applicant has not qualified what constitutes a gradual increase in force.

The applicant disagrees with the above. Applicant’s claim 18 calls for:

“the simultaneous submersion of the bobber main body and the displacement of the member with respect to the bobber main body so as to provide gradual resistance.”  
(Emphasis added.)

The applicant submits that Ingram’s fishing float does not provide for a gradual resistance.

As the Office noted, Ingram’s “stem is pulled down before the body 10.” (Page 4, line 12 of Office action.) Note in Figures 1 and 3 that Ingram’s stem member 12 is shown to include a

lower tapered portion 16, which allows stem member 12 to be displaced in the water with less resistance than if the lower portion of the stem member 12 was not tapered.

Further note that Ingram's body 10, as shown in Ingram's Figures 1 and 3, includes a flat and circular-shaped base. The applicant submits that the flat and circular-shaped base of Ingram's float body 10 will require more force to downwardly displace float body 10 in the water than if the base of the body 10 was not flat, i.e. tapered.

Since Ingram's stem member 12 submerges before Ingram's fishing float body 10 and since the lower tapered portion 16 of Ingram's stem member 12 allows the stem member 12 to be displaced in a body of water with less resistance while the flat and circular-shaped base of Ingram's body 10, on the other hand, will result in more resistance to the downwardly displace of the float body 10 in the body of water, the applicant submits that there will be an abrupt change in the force of resistance when Ingram's float body begins to submerge.

Since there will be an abrupt change in the force of resistance when Ingram's float body begins to submerge the applicant submits that Ingram's fishing float does not provide for a "gradual resistance."

In regards to the Office's statement that "Applicant has not qualified what constitutes a gradual increase in force," the applicant submit that the term "gradual" is defined as:

"proceeding or taking place slow, step by step, not steep or abrupt, a *gradual improvement*" (Emphasis added)

(The New Lexicon Webster's Dictionary of the Language, 1989 Edition)

Applying the above-definition, since there will be an abrupt change in the force of resistance when Ingram's float body begins to submerge in the body of water for the reasons stated above, the applicant submits that Ingram's fishing float does not provide for a gradual resistance. If the Office has knowledge of any different definition for the term "gradual," the applicant respectfully request to be provided with such.

In regards to the Office's statement that "Applicant has submitted no evidence that there is not a gradual increase in the force to displace the members of Ingram," the applicant submits that under *In Re Wilder*, any burden of proof as to the cited prior art is initially placed upon the Office and not on the applicant. See *In Re Wilder*, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970), also see *In re King*, 231 U.S.P.Q. 136, 138-139 (Fed. Cir. 1986).

The applicant further submits that the Office has not provided evidence that Ingram's stem member 12 and float body 10 simultaneously submerge to provide for gradual resistance.

In further regards to the Office's above statement, the applicant also submits that "a gradual increase in the force to displace the members of Ingram," is not at issue. Instead, the issue is whether Ingram's stem member 12 and float body 10 simultaneously submerge to provide for gradual resistance as called for by applicant's claim 18. A review of Ingram revealed no reference to the simultaneous submersion of Ingram's stem member 12 and float body 10 with "gradual resistance" or that Ingram's device provides for a gradual resistance.

It is for the above reasons that applicant submits that the reference of Ingram does not teach his device as providing for gradual resistance.

**Rejection under 35 U.S.C. 103(a)**

**A. It would not have been obvious to employ a force to displace Ingram's stem member to a down position equal to the buoyant force of Ingram's buoyant body.**

Applicant's claim 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the reference of Ingram. In rejecting claim 19, the Office held that:

“it would have been obvious to employ a force to displace the member to a down position equal to the buoyant force of the bobber main body so that when the member is in the down position the bobber main body is submerged since this is merely a matter of design choice since not stated problem is solved.” (Page 3, lines 15-18.)

The applicant respectfully but strenuously disagrees with the above. In regards to the applicant's claim 19, claim 19 calls for:

“the force to displace said member to a down position is substantially equal to the buoyant force of the bobber main body so that the when the member is in the down position the bobber main body is submerged.”

The applicant submits that the reference of Ingram does not teach the force to displace his stem member 12 to a down position as being substantially equal to the buoyant force of Ingram's float body 10. Instead, as the Office noted on page 3, lines 13-14 of the office action, the reference of Ingram “shows a two stage fishing bobber which forces down the member and then the main body.” (Emphasis added.) Ingram's purpose for having his stem

member 12 displaced "below the surface of the water" before the downward displacement of his float body 10 is to allow his stem member 12 to provide for an indicator of a striking fish. (See column 2, lines 25-30 of Ingram.)

The applicant submits that employing a force to displace Ingram's stem member 12 to a down position equal to the buoyant force of Ingram's float body 10, as called for by the Office, is a contrary teaching to the reference of Ingram. Note that employing a force to displace Ingram's stem member 12 to a down position equal to the buoyant force of Ingram's float body 10 will result in Ingram's float body 10 being submerged when the Ingram's stem member 10 is in the down position thereby eliminating the specifically disclosed fish striking indication aspect of Ingram's fishing float.

In further regards the Office's above statements, as discussed above, the reference of Ingram does not teach a force to displace Ingram's stem member 12 to a down position equal to the buoyant force of Ingram's float body 10. A review of Ingram indicates that Ingram fails to teach the aforementioned. Instead, Ingram is a contrary teaching by his disclosure of "a two stage fishing bobber which forces down the member and then the main body," (noted by the Office on page 3, lines 13-14), to provide for a fish striking indicator (column 2, lines 25-30 of Ingram).

In view of the aforementioned, the applicant submits that by employing a force to displace Ingram's stem member 12 to a down position equal to the buoyant force of Ingram's float body 10 so that when the stem member 12 is in the down position the float body 10 is

submerged, that the Examiner is using impermissible hindsight reconstruction to yield the applicant's invention as Ingram does not teach the aforementioned but instead teaches away from such.

In the case of *In re Fine*, the C.A.F.C. held that:

“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” Emphasis added, see *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

In further regards to the Office's contention that the limitation as disclosed in dependent claim 19 " is merely a matter of design choice since not stated problem is solved," the applicant disagrees.

The applicant submits that since providing a force to displace a member to a down position substantially equal to the buoyant force of the bobber main body will operate to reduce or eliminate the abrupt changes in the resistance to a downward displacement of a fishing bobber in a body of water resulting from the submersion of bobber main body, that the above is not a matter of design choice but instead solves a stated problem, namely reducing some of the factors which might cause a fish to spit out a hook.

It is for the above reasons that applicant submits that it would not have been obvious to employ a force to displace Ingram's stem member 12 to a down position equal to the buoyant force of Ingram's buoyant body 10. As such, the applicant further submits that claim 19 is allowable over the reference of Ingram.



**B. It would not have been obvious to combine the reference of Ingram with the reference of Behensky**

**I. Behensky's tube 10, cap member 15, and spring 16 are not an equivalent mechanical member to Ingram's stem member 12.**

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ingram and Behensky. In rejecting claim 20, the Office held that:

“The patents to Ingram and Behensky show fishing floats. Ingram has been discussed above and does not show a spring. The patent to Behensky shows a resiliently displaceable member 10, 15 with a spring 16. In reference to claim 20, it would have been obvious to provide Ingram with a displaceable member as shown by Behensky since merely one equivalent mechanical member is being replaced with another to hold the fishing line in the bobber main body.” (Page 4, lines 1-5.)

The applicant respectfully disagrees with the above.

**a. Combining Ingram with Behensky will destroy the novelty of Ingram**

The applicant submits that replacement of Ingram's stem member 12 with Behensky's tube 10, cap member 15, and spring 16 will destroy the novelty of Ingram's invention

Ingram in column 1, lines 12 and 19 and column 2, lines 33-34 specifically states that the novelty of his device is by the “nature of its relatively moveable parts,” more specifically, the relative moveability of his stem member 12 with respect to his fishing float body 10. In

column 1, lines 13-16 Ingram further discloses that the relative moveability of his stem member 12 with respect to his float body 10 result in:

"the stem being subject to movement, independent of the float body, upon the striking of a fish on an associated line." (Emphasis added.)

The independent moveability of Ingram's stem with respect to his float body 10 allows Ingram's fishing float to provide for an indication of a striking fish "by the disappearance of the stem within the buoyant body." (Emphasis added, column 2, lines 27-30.)

Behensky, in column 1, lines 2-6 specifically discloses "a float which is capable of securing and releasing a fishing line to permit adjusting the float in accordance with the depth of the water where it is to be employed." Behensky accomplishes the above by the use of a spring 16:

"positioned about the cylindrical tube 10 and bears against the cap member 15 and the shoulder 8 of the cylindrical sleeve 4 to exert an upward force on the tube 10, which urges the flared portion 11 thereof towards the tapered seat 9 of the sleeve 4 to firmly grip a line passing therebetween." (Emphasis added, see column 3, lines 25-32.)

In column 3, lines 54-60, Behensky states that in order to displace his tube 10, force is required to be exerted "on the upper side of the cap member 15, sufficient to overcome the force exerted by the spring 16." (Emphasis added.) Note that Behensky's tube 10 is displaced with respect to his float body portion 1 to release his fishing float from the line for the purpose of adjustment, that is, the displacement of Behensky's tube 10 with respect to his float body portion 1 causes "the flared portion 11 of the tube 10 to move away from tapered

seat 9, and to release the line, allowing the float to be positioned at the desired point along the line.” (Column 3, lines 54-60.)

Further note that since Behensky requires sufficient force to be exerted “on the upper side of the cap member 15 in order to displace his tube 10 with respect to his body portion 1, Behensky's tube 10 does not move independent of Behensky's body portion 1 upon the striking of a fish on Behensky's fishing line 13 as a downward pull on fishing line 13 will not exert a force on the upper side of Behensky’s cap member 15 sufficient to displace Behensky’s tube 10. (See column 3, lines 24-33 of Behensky.)

In view of the above, the applicant submits that providing “Ingram with a displace able member as shown by Behensky” would destroy the novelty of the “relatively moveable parts” of Ingram’s fishing float since Behensky’s tube 10 is not permitted to move unless sufficient external force is exerted against the upper side of his cap member 15.

**b. Behensky's tube 10, cap member 15, and spring 16  
function differently than Ingram's stem member 12**

In further regards to the Office’s above statement, the applicant submits that Behensky's tube 10, cap member 15, and spring 16 are not an equivalent mechanical member to Ingram's stem member 12 as Behensky's tube 10, cap member 15, and spring 16 functions differently than Ingram's stem member 12.

In column 2, lines 20-30, Ingram discloses that “as a fish strikes the lower end of the line,” the relatively movable parts of his fishing float allows for the downward displacement of his stem member 12 followed by the downward displacement of Ingram’s float body 10. Thus the striking of a fish is indicated, first, by the disappearance of the stem within the buoyant body and, secondly, by the disappearance of the entire float. In contrast, as illustrated by Figures 11-13 the applicant’s disclosure, the applicant’s stem 13 and bobber body 15 simultaneously submerge in one continuous action due to the gradual resistance to submersion provided by applicant’s fishing bobber.

Behensky's tube 10, cap member 15, and spring 16 do not cooperate with the rest of the parts of Behensky’s fishing float to perform the above. As previously noted, a downward pull on Behensky’s fishing line 13 will not exert sufficient force on the upper side of Behensky’s cap member 15 to downwardly displace Behensky’s tube 10 with respect to his body portion 1.

However, even if Behensky’s tube 10 is downwardly displaced, the downward displacement of Behensky’s tube 10 with respect to his body portion 1 is not followed by the downward displacement of Behensky’s body portion 1 as the downward displacement of Behensky’s tube 10 with respect to his body portion 1 will release the hold of his fishing float’s on line 13. As a result, fishing line 13 will move independent of Behensky’s fishing float thereby preventing the downward displacement of Behensky’.

**c. Behensky's tube 10, cap member 15, and spring 16 are a contrary teaching to Ingram's stem member 12.**

The applicant also submits that the combination of Behensky's tube 10, cap member 15, and spring 16 is not an equivalent mechanical member to Ingram's stem member 12 but instead is a contrary teaching.

In column 2, lines 20-26, Ingram discloses that:

“as a fish strikes the lower end of the line, the attached stem will move downwardly through the bore of the body until the top of the stem is flush with the top surface of the body; the body then is subjected to the downward pull on the line and will disappear from sight below the surface of the water.”

That is, Ingram's stem member 12 maintains a hold on the fishing line while the stem member 12 is displaced with respect to the float body 10. The continual hold on the fishing line by Ingram's stem member 12 allows for further displacement of Ingram's float body. (Also see Figures 1-3 of Ingram.)

Behensky, on the other hand, discloses that his spring 16:

“urges the flared portion 11 thereof towards the tapered seat 9 of the sleeve 4 to firmly grip a line passing therebetween.” (Emphasis added, see column 3, lines 25-32.)

The displacement of Behensky's tube 10 with respect to his body portion 1 causes “the flared portion 11 of the tube 10 to move away from the tapered seat 9, and to release the line.” (Column 3, lines 56-60.) That is, contrary to the teaching of Ingram, the displacement of

Behensky's tube 10 with respect to his body portion 1 results in the releasing of his fishing float's hold on the fishing line. As a result, the displacement of Behensky's tube 10 prevents the displacement of Behensky's body portion 1.

**d. No motivation, suggestion or incentive  
to the combination**

In further regards to the above, the applicant submits that there is no suggestion, motivation, or teaching Ingram and Behensky that would lead to their combination, and more specifically, to the replacement of Ingram's stem member 12 with Behensky's tube 10, cap member 15, and spring 16.

The device of Ingram is directed to a fishing float having a stem that is independently moveable with respect to the float body to allow the fishing float to provide for an indication of a striking fish "by the disappearance of the stem within the buoyant body." (Emphasis added, column 2, lines 26-30.) Note that the displacement of Ingram's stem member 12 is followed by the displacement of the float body 10.

The device of Behensky is direct to "a float which is capable of securing and releasing a fishing line to permit adjusting the float in accordance with the depth of the water where it is to be employed." (Emphasis added, see column 1, lines 2-6.) Note that Behensky's fishing float requires sufficient force to be exerted "on the upper side of the cap member 15 in order to displace his tube 10 with respect to his body portion 1.

Behensky does not provide for an indication of a striking fish prior to the downward displacement of his float body portion 1 as Behensky's tube 10 does not move independent of Behensky's body portion 1 upon the striking of a fish on his fishing line 13. The downward pull on Behensky's fishing line 13 also will not exert a force on the upper side of Behensky's cap member 15 sufficient to downwardly displace Behensky's tube 10.

Note that the displacement of Behensky's tube 10 with respect to his body portion 1 results in his fishing line 13 being release from his fishing float. As a result, unlike Ingram's fishing float, the displacement of Behensky's tube 10 with respect to his body portion 1 is not followed by the displacement of Behensky's body portion 1. Further note that Ingram is not concerned with the adjustment of his float in accordance with the depth of the water where it is to be employed per his simple use of wedge 18 to secure his fishing float to the fishing line.

In *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, the Court of Appeals Federal Circuit held that:

“In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.” Emphasis added, see *Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001)

In view of the above, the applicant submits that there is no suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to replace Ingram's stem member 12 with Behensky's tube 10, cap member 15, and spring 16.

**II. It would not have been obvious to replace the wedge 18 and tube 13 of Ingram's device with Behensky's spring 16, tube 10 and hollow cylindrical sleeve 4.**

On page 4, lines 17-19 and page 5, lines 1-4 of the office action, the Office stated that:

"Both Ingram and Behensky use the wedge and the spring to hold the fishing line fixed with respect to the float. Behensky permits the float to be adjusted on the line. The combination of Ingram as modified by Behensky contemplates not only the spring but also the tube 10 and hollow cylindrical sleeve 4 as a unit to replace the wedge 18 and tube 13 of Ingram so that the stem member is displace able with respect to the float body and the line is held between the tube and cylindrical sleeve."

The applicant respectfully disagrees with the Office's above statement.

**a. Simplicity versus Complexity**

The applicant submits that it would not have been obvious to replace Ingram's wedge 18 and tube 13 with Behensky's spring 16, tube 10 and hollow cylindrical sleeve 4 as Ingram teaches away from Behensky's system for securing a fishing line to Behensky's fishing float.

In column 2, lines 35-36, Ingram discloses that his invention "is characterized by it simplicity of construction." (Emphasis added) Note that Ingram's disclosure of "a fishing float comprising a relatively stationary float body have a vertically movable stem" with the stem having "an internal open line-receiving tube 13" follows Ingram's simplicity of construction. Further note that Ingram's use of the wedge 18 for securing his float to a fishing line also follows Ingram's simplicity of construction.



Behensky, on the other hand, discloses his fishing float as having a “unique structure which is readily adjustable along a fishing line; practicable for use in deep water fishing.” (Emphasis added, see column 1, lines 32-35 of Behensky.) Note that Behensky’s discloses that his system for securing a fishing line to his fishing float alone includes (1) a cylindrical tube 10 having a cap 15 and a lower flared portion 11, (2) a “hollow cylindrical sleeve 4 having an enlarged lower end portion 5” (col. 2, lines 45-47), with the sleeve having an internal diameter that “decreases in diameter to form a shoulder 8” (col. 3, lines 3-7), and (3) a spring 16 “positioned about the cylindrical tube 10” and bearing “against the cap member 15 and the shoulder 8 of the cylindrical sleeve 4 to exert an upward force on the tube 10 (col. 3, lines 25-30). (Emphasis added.) Applicant submits that Behensky’s above system for securing his fishing float to the fishing line goes against Ingram’s simplicity of construction.

In view of the complexity of Behensky’s above “system” for securing the fishing line to his fishing float, the applicant submits that it would not have been obvious to replace Ingram’s wedge 18 and tube 13 with Behensky’s above “system” as the replacement of Ingram’s wedge 18 and tube 13 with Behensky’s above “system” would destroy the simplicity of construction that is characterized by Ingram’s fishing float.

#### **b. Hindsight reconstruction**

The applicant further submits that by combining the device of "Ingram as modified by Behensky," that the Office is using impermissible hindsight reconstruction by simply picking

isolated elements from each distinct invention of the prior art and combining them to yield the applicant's invention as disclosed in dependent claim 20. As previously cited:

“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” Emphasis added, see *In re Fine*, at 1600.

The applicant also submits that even if one were to combine the references of Ingram and Behensky, their combination still does not make the applicant's claim 20 obvious.

Applicant's amended claim 20 calls for:

“the resiliently displaceable member comprises a spring such that the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.” (Emphasis added.)

The combination of Ingram and Behensky does not teach the total force to compress the spring as being “approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.”

**C. The reference of Behensky does not teach a spring whose constant is about equal to the spring constant of the bobber in water**

On page 5, lines 4-5 of the office action, the Office stated that:

“Behensky shows a spring whose constant is about equal to the spring constant of the bobber in water.”

The applicant disagrees with the above and respectfully request that the Office provide evidence to support the above.

The applicant submits that a reviewed Behensky fails to disclose “a spring whose constant is about equal to the spring constant of the bobber in water.” Behensky instead, discloses a spring 16 for exerting “an upward force on the tube 10, which urges the flared portion 11 thereof towards the tapered seat 9 of the sleeve 4 to firmly grip a line passing therebetween.” (Column 1, lines 25-32.) Note that the force exerted by Behensky’s spring 16 is sufficient to urge his flared portion 11 towards his “tapered seat 9 of sleeve 4 to firmly grip a line passing therebetween.” (See column 3, lines 25-33 and column 3, lines 53-60.)

Applicant submits that a spring having a constant “equal to the spring constant of the bobber in water” is different from a spring having a force sufficient to urge Behensky’s flared portion 11 towards the tapered seat 9 of his sleeve 4 “to firmly grip a line passing therebetween.”

The applicant’s claim 20 has been amended to call for stage fishing bobber :

“wherein the resiliently displaceable member comprises a spring having a spring constant that is about equal to a spring constant of the bobber in water such that the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.” (Emphasis added.)

The applicant submits that a reviewed Behensky also fails to disclose the above. Applicant further submits that Behensky is not concerned with a spring having a total force of compression approximately equal to the total force require to submerge Behensky’s tube 10

and body portion 1. Note in column 3, lines 25-33 and column 3, lines 53-60 wherein Behensky discloses the force exerted by Behensky's spring 16 as being the force necessary to urge Behensky's flared portion 11 towards his "tapered seat 9 of sleeve 4 to firmly grip a line passing therebetween." Applicant submits that the force necessary to urge Behensky's flared portion 11 to firmly grip a line is different from the total force require to submerge Behensky's tube 10 and body portion 1.

On page 5, lines 5-7 of the office action, the Office further stated that:

"Applicant provides no data on the exact numbers of the spring constant or the spring constant of the bobber in water and does not prove that the spring constant of the spring used by Behensky is materially different than that of the present invention."

In regards to the above, the applicant submits that "data on the exact numbers of the spring constant or the spring constant of the bobber" was not provide as the exact numbers of the spring constant are dependent on the shapes and sizes of the bobber body.

In regards to the Office's statement that the applicant "does not prove that the spring constant of the spring used by Behensky is materially different than that of the present invention," applicant submits that, under *In Re Wilder*, any burden of proof as to the cited prior art is initially placed upon the Office and not on the applicant. Emphasis added, see *In Re Wilder*, at 548. In view of the aforementioned, applicant submits that it is the Office's burden to prove "that the spring constant of the spring used by Behensky" is the same as the spring constant of the spring of the applicant's invention. Applicant submits that the Office has not

proven “that the spring constant of the spring used by Behensky” is the same as the spring constant of the spring of the applicant’s invention.

In further regards to the applicant’s claims 19 and 20, claims 19 and 20 each depend on independent claim 18. Since independent claim 18 is allowable for the reasons given above, applicant submits that dependent claims 19 and 20 are also patentable.

In view of the above, it is submitted that the application is in condition for allowance.

Allowance of claims 18 and 19 and amended claims 20 is respectfully requested. Applicant has enclosed a marked-up version of the amendment showing changes made with this response.

**VERSION OF AMENDMENTS SHOWING MARKINGS**

**In the Claims**

Please amend the claims as follows:

20. (Amended) The two stage fishing bobber of claim 18 wherein the resiliently displaceable member comprises a spring having a spring constant that is about equal to [the] a spring constant of the bobber in water [or] such that the total force to compress the spring with respect to the bobber main body is approximately equal to the total force to submerge the bobber main body and the resiliently displaceable member.

Respectfully submitted,

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